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a section identifier configured to identify a section in the contents based on a preference of a user;
a section manipulator configured to re-format the identified section to generate a new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user; and
such that the new rendition can be displayed on the specific class of devices.

4. A computer-aided apparatus as recited in claim 3 wherein the user is selected from the group of an end-user viewing the new rendition and the provider of the set of contents.

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed September 17, 2002.

The drawings filed on April 30, 1999 were objected to by the Examiner. Reconsideration of the objection is respectfully requested.

Claims 1-4 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 1-4. The present Response amends Claims 1 and 3 to more clearly claim and distinctly point out Applicants' invention, leaving for the Examiner's present consideration Claims 1-4. Reconsideration of the rejections is requested.

The present response amends the specification to correct several simple typographical errors. No new matter is added by the amendments to the specification.

I. SUMMARY OF EXAMINER'S OBJECTIONS

The drawings were objected to under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims.

II. SUMMARY OF EXAMINER'S REJECTIONS

Claims 1-4 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention.

Claims 1 and 3 were rejected under 35 U.S.C. 102(e) as being anticipated by Rangan et al. (U.S. Pat. No. 6,154,771).

Claims 2 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rangan et al. (U.S. Pat. No. 6,154,771) as applied to claims 1 and 3 and further in view of Tognazzini et al. (U.S. Pat. No. 5,731,805).

III. SUMMARY OF APPLICANTS' AMENDMENTS

Claims 1 and 3 have been amended. Applicants respectfully request reconsideration of Claims 1-4.

IV. RESPONSE TO OBJECTIONS

The Examiner objected to the drawings under 37 C.F.R. 1.83(a). The Examiner stated that, "[t]he drawings must show every feature of the invention specified in the claims," and that "all features in claims 1-4 must be shown in the drawings or the feature(s) canceled from the claim(s)." (*Office Action*, mailed September 17, 2002, page 2, para. 1.)

However, pursuant to 37 C.F.R. 1.81(a), drawings are only required “where necessary for the understanding of the subject matter sought to be patented.” Applicants respectfully submit that drawings are not necessary for an understanding of every feature recited in Claims 1-4. The written description sets forth the Applicants’ invention in such clear and concise terms to enable one skilled in the art to make and use the claimed invention.

V. RESPONSE TO REJECTIONS

A. REJECTION OF CLAIMS 1-4 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner rejected Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully request reconsideration of this rejection in light of the claim amendments and the following remarks.

1. WRITTEN DESCRIPTION

The Examiner stated that:

There does not appear to be a written description of the limitation “identifying a section in the contents based on a preference of a user; and reformatting the identified section to generate a new rendition, depending on a character of the specific class of devices and a preference of the user; such that the new rendition can be displayed on the specific class of device” in claims 1 and 3 and “the user is selected from the group of an end-user viewing the new rendition and the provider of the set of contents.” (*Office Action*, page 2, para. 3.)

Applicants respectfully submit that there is adequate written description for each and every limitation of Claims 1-4 and that the claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants respectfully submit that there is sufficient written description for the limitation “identifying a section in the contents based on a preference of a user” as recited in Claim 1 and “a section identifier configured to identify a section in the contents based on a preference of a user” as recited in Claim 3.

For example, the specification states that, “a content provider, can identify an area in the original rendition, and place it as a component in the new rendition. This can be done in a number of ways. For example, the customizer can include a section identifier and a section manipulator. The identifier identifies a section in the original rendition.” (*Specification*, page 15, lines 25-29). The specification goes on to state that, “[b]ased on the section identifier, a user can navigate from section to section in the original rendition, such as moving from the header to the left hand column. If the user wants a particular section, the user can highlight it.” (*Specification*, page 16, lines 2-5.)

Thus, based on the above examples, Applicants submit that there is sufficient written description for the limitation, “identifying a section in the contents based on a preference of a user” as recited in Claim 1, and “a section identifier configured to identify a section in the contents based on a preference of a user,” as recited in Claim 3.

Additionally, there is sufficient written description for the amended limitation, “re-formatting the identified section to generate a new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user,” as recited in Claim 1 and “a section manipulator configured to re-format the identified section to generate a

new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user,” as recited in Claim 3.

The specification describes re-formatting “the identified section” as recited in Claims 1 and 3. For example, page 15 describes that, “[a]fter the section is identified, the [section] manipulator copies that section, and automatically places it as a component in the new rendition. This could be achieved through a drag-and-drop metaphor.” (*Specification*, page 15, line 29-page 16, line 2). Additional support for “formatting based upon a characteristic of the specific class of devices” is also provided. “For example, a DocTV designates an appliance specific transducer for modifying a document for television viewing. This transducer can include a number of sub-transducers, such as a format sub-transducer for TV to change the format of the image depending on the television.” (*Id.*, page 9, lines 19-23.)

Further, there is adequate written description for the limitation, “such that the new rendition can be displayed on the specific class of devices,” as recited in Claims 1 and 3. One embodiment states that, “[t]he new rendition depends on the characteristics of the specific class of devices. For example, if the specific class of devices is a pager, and the section selected is a title with a large font size on the original rendition, the font size of the title can be reduced to fit into the screen of the pager.” (*Specification*, page 16, lines 12-15.)

Finally, written description is also provided for the limitation that “the user is selected from the group of an end-user viewing the new rendition and the provider of the set of contents,” as recited in Claims 2 and 4. Page 16 of the application states that, “the re-formatting can be under the control of a content provider. However, an end-user can be in control of the process, or both the end-user and the content

provider can control the process. Thus, users, who can be content providers or end users, can have a predetermined rendition of contents re-formatted as desired.” (*Id.*, page 16, line 25-page 17, line 1.)

2. CLARITY

The Examiner also stated that, “[t]he claims’ language in claims 1-4 are not appropriate because it is not clear that what the applicant intend to claim, e.g., identifying section of content, reformat the identified section.” Applicants respectfully submit that the amended claim language is clear as to what Applicants intend to claim and reconsideration of this rejection is requested.

Amended Claims 1 and 3 distinctly and particularly claim an apparatus and method for, “generating (generate) an image of a pre-determined rendition of the set of contents; identifying (identify) a section in the contents based of a preference of a user; re-formatting (re-format) the identified section to generate a new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user; and such that the new rendition can be displayed on the specific class of devices.” Applicants submit that the subject matter of the claims is clearly set forth by amended Claims 1 and 3. As described in the specification, an “embodiment of the present invention includes an image generator, and a customizer to re-format a pre-determined rendition of contents, such as a Web page, into a new rendition, for a specific class of devices, based on preferences of content providers or end users or both.” (*Specification*, page 15, lines 12-15.)

The Examiner also stated that, “it is not clear that the user is selected from the content of from the provide. The claim language as written could be broadly read on several means and function including read on hotspot, hyperlink on a web page as being applied below.” Applicants respectfully submit that it is clear that “the user is selected from the group of an end-user viewing the new rendition and the provider of the

set of contents” as recited in Claims 2 and 4. Applicants teach that end users *and* content providers can be users controlling the process, stating that, “an end-user can be in control of the process, or both the end-user and the content provider can control the process.” (*Specification*, page 16, lines 26-27).

Applicants further submit that the claim language as written, does not “broadly read on several means and function including read on hotspot, hyperlink on a webpage as being applied below.” As will be discussed in more detail below, “hotspot” and “hypervideo,” as disclosed in U.S. Patent No. 6,154,771 (“*Rangan*”), “presents a scenario where the user jumps to another resource by clicking a hotspot associated with an abject in video.” (*Rangan*, col. 27, lines 4-6.) As *Rangan* states, “hotspots and associated hyperlinks, which are typically links to advertisements or advertising-related promotions (directly, or indirectly in accordance with the present invention the explanation of which is ensuing) may be inserted either into stored, or into live, video content.” (*Rangan*, col. 24, lines 6-10.) The present application, however, claims “re-formatting the identified section to generate a new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user.” Hotspots and hyperlinks, as taught by *Rangan*, provide new information rather than re-formatting an identified section.

Accordingly, Claims 1-4 as amended are believed patentable under 35 U.S.C. §112 and reconsideration of the rejection is requested.

B. REJECTION OF CLAIMS 1 AND 3 UNDER 35 U.S.C. 102(e)

The Examiner rejected Claims 1 and 3 under 35 U.S.C. 102(e) as being anticipated by *Rangan*. Applicants respectfully submit that *Rangan* does not disclose every limitation of Claims 1 and 3, and therefore, cannot anticipate Claims 1 and 3.

Rangan does not teach “re-formatting (re-format) the identified section to generate a new rendition including the identified section, wherein the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user” as recited in amended Claims 1 and 3. The Examiner states that, “*Rangan* discloses upon click in on hotspot the system provides new contents associated to the hot spot.” As the Examiner states, “the system provides *new* contents.” (*Office Action*, page 4, para. 7) (emphasis added). Applicants’ amended Claims 1 and 3, however, recite “to generate a new rendition including the identified section.”

All of the portions of *Rangan* cited by the Examiner teach providing new information rather than “re-formatting (re-format) an identified section to generate a new rendition including the identified section,” as recited in Claims 1 and 3. In Col. 24, lines 6-37, *Rangan* teaches the use of hotspots to provide additional information such as advertisements when a user invokes a hotspot or hyperlink. FIG. 5 illustrates a screen display with “the most recent thumb-nail images, representing twenty most recent scenes.” (*Rangan*, col. 26, lines 31-32.) “The SUV can click on any of the scenes to start recording from that scene.” (*Id.*, col. 26, lines 36-37.) In Col. 26, lines 47-63 which describe FIG. 6 and FIG. 7, *Rangan* discloses “how a Client SUV whose VOW VCR is playing hypervideo may click on a hotspot to branch to a network page display, or ‘web page’” and “to alternatively branch to another video, or hypervideo.”

FIG. 8 illustrates clicking a hotspot to generate “a slide show accompanied by audio.” (*Id.*, col. 27, line 2.)

As described, each of the teachings of *Rangan* disclose generating new content or information such as a web page or another video as illustrated by FIG. 6 and FIG. 7, or recording video as illustrated by FIG. 8. *Rangan* does not teach or disclose “re-formatting (re-format) the identified section to generate a new rendition including the identified section,” as recited in Applicants’ Claims 1 and 3. Furthermore, *Rangan* does not disclose “the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the user.” *Rangan* discloses the use of hotspots and hyperlinks to provide additional content in response to user requests but not content re-formatted for “the specific class of devices and the preference of the user.”

Thus, since *Rangan* does not teach each of the limitations of Claims 1 and 3, *Rangan* cannot anticipate Claims 1 and 3. Accordingly, withdrawal of the Examiner’s rejection of Claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by *Rangan* is requested.

C. REJECTION OF CLAIMS 2 AND 4 UNDER 35 U.S.C. 103(a)

Claims 2 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Rangan*, as applied to Claims 1 and 3 and further in view of *Tognazzini et al.* (U.S. Pat. No. 5,731,805). The Examiner stated that “*Rangan* does not express selecting the user from the group of an end-user viewing the new rendition and the provider of the set of contents,” but that “selecting a user from group of users to view a content based on the type of content was well known in the art, such technique was known as targeting information, which allow content provider to narrowly transmits certain type of web content to

a specific user(s), as has been taught by *Tognazzini* (Col. 16, lines 29-45).” Thus, according to the Examiner, it would have been obvious to incorporate the technique taught by *Tognazzini* into *Rangan*’s system.

Claims 2 and 4 each depend on independent Claims 1 and 3 respectively, and are therefore at least patentable for the reasons mentioned above. Furthermore, col. 16, lines 29-45 teach the selection of news articles based on a determined user interest. *Tognazzini* states that, “this allows the information provider to narrowly target advertising and articles to each user.” *Tognazzini*, like *Rangan*, does not teach or suggest “the new rendition is formatted based upon a characteristic of the specific class of devices and the preference of the ‘end-user viewing the new rendition’ or ‘the provider of the set of contents’” as recited in Claims 2 and 4.

Thus, since *Rangan* and *Tognazzini*, either or alone or in combination, fail to teach or suggest each of the limitations of Claims 2 and 4, Claims 2 and 4 cannot be obvious over *Rangan* in view of *Tognazzini*. Accordingly, withdrawal of the Examiner’s rejection of Claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Rangan* as applied to Claims 1 and 3 and further in view of *Tognazzini* is requested.

VI. CONCLUSION

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

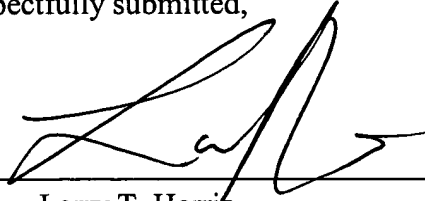
In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is

respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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